

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

DePuy Mitek, Inc.
a Massachusetts Corporation

Plaintiff,

v.

Arthrex, Inc.
a Delaware Corporation, *et al.*

Defendants.

Civil Action No. 04-12457 PBS

**DEFENDANTS ARTHREX, INC.'S AND PEARSALLS, LTD.'S SUPPLEMENTAL
MEMORANDUM RELATING TO PATENT OWNERSHIP**

Dated: August 9, 2007

Charles W. Saber
Stephen A. Soffen
Salvatore P. Tamburo
DICKSTEIN SHAPIRO LLP
1825 Eye Street, N.W.
Washington, D.C. 20006-5403
Telephone: (202) 420-3116
Facsimile: (202) 420-2201

Christopher Weld, Jr. (BBO # 522230)
Raymond P. Ausrotas (BBO # 640315)
TODD & WELD LLP
28 State Street, 31st Floor
Boston, MA 02109
Telephone: (617) 720-2626
Facsimile: (617) 227-5777

Counsel for Defendants
Arthrex, Inc. and Pearsalls Ltd.

**DEFENDANTS ARTHREX, INC.'S AND PEARSALLS, LTD.'S SUPPLEMENTAL
MEMORANDUM RELATING TO PATENT OWNERSHIP**

Defendants Arthrex, Inc. and Pearsalls, Ltd. submit this paper in response to the Court's question about the impact of state law on the need for consideration in a patent assignment.

Defendants cited *Thomas v. Webster Spring Co., Inc.*, 638 N.E.2d 51, 53 (Mass. App. Ct. 1994), a case interpreting Massachusetts law, in their memorandum filed August 7, 2007, to support the assertion that a patent assignment requires consideration. The *Thomas* court held that notwithstanding the assertion that the patent assignment, like here, recited the words "for good and valuable consideration;" the assignment failed because the facts showed that there was *no* consideration. *Id.* Thus, under Massachusetts law, consideration must be shown for there to be a valid assignment. To find otherwise would potentially subject Defendants to multiple lawsuits should Ethicon, Inc., like Thomas, seek to nullify the "Assignment" for lack of consideration.

For the foregoing reasons, the Court should find that DePuy Mitek is not the owner of the '466 Patent.

Dated: August 9, 2007

Respectfully submitted,

By: /s/Charles W. Saber

Charles W. Saber

Stephen A. Soffen

Salvatore P. Tamburo

DICKSTEIN SHAPIRO LLP

1825 Eye Street, N.W.

Washington, D.C. 20006-5403

Telephone: (202) 420-3116

Facsimile: (202) 420-2201

Christopher Weld, Jr. (BBO # 522230)

Raymond P. Ausrotas (BBO # 640315)

TODD & WELD LLP

28 State Street, 31st Floor

Boston, MA 02109

Telephone: (617) 720-2626

Facsimile: (617) 227-5777

Counsel for Defendants

Arthrex, Inc. and Pearsalls Ltd.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing DEFENDANTS ARTHREX, INC.'S AND PEARSALLS, LTD.'S SUPPLEMENTAL MEMORANDUM RELATING TO PATENT OWNERSHIP was served, via the Court's email notification system on the following counsel for Plaintiff on the 9th day of August 2007:

Lynn A. Malinoski
Woodcock Washburn, LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

Daniel J. Gleason
Nutter McClennan & Fish LLP
World Trade Center West
155 Seaport Boulevard
Boston, MA 02210-2604
Telephone: (617) 439-2000
Facsimile: (617) 310-9000

/s/Charles W. Saber